

REMARKS

In the Office Action,¹ the Examiner rejected claims 1-3 and 7 under 35 U.S.C. § 102(e), as being anticipated by *Schmiedchen et al.*, U.S. Patent No. 7,192,181, (“*Schmiedchen*”). The Examiner also rejected claims 4 and 6 under 35 U.S.C. § 103(a), as being unpatentable over *Schmiedchen* in view of *Jolidon*, U.S. 2005/0007888 (“*Jolidon*”), and objected to claims 5 and 8-10 as being dependent upon a rejected base claim, but allowable if rewritten in independent form.

Claims 1-10 are pending in the present application. Applicants traverse the rejections and request allowance of the pending claims for at least the following reasons.

I. Rejection of Claims 1-3 and 7 under 35 U.S.C. §102(e)

Applicants respectfully traverse the rejection of claims 1-3 and 7 under 35 U.S.C. § 102(e), as being anticipated by *Schmiedchen*. In order to properly establish that *Schmiedchen* anticipates Applicants’ claims under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Independent claim 1 recites a display device intended to be fitted to a watch movement, where the display device includes, among other things, “a display disk for an additional function, a display gearing of which one moving part carries the display disk, [and] a second energy source, connected mechanically to the display gearing.” The prior art of record fails to teach or suggest all of the elements of claim 1.

In the Office Action, the Examiner contends that the “aperture date device 33” of *Schmiedchen* anticipates the “display disk” recited in claim 1. Office Action, p. 2. Even if aperture date device 33 equates to or inherently includes a “display disk”, which Applicants do not concede, *Schmiedchen* does not disclose or suggest a “display gearing” for carrying a “display disk” (aperture date device 33 or otherwise) and a “second energy source” connected mechanically to the display gearing, as set forth in claim 1. *Schmiedchen* discloses that timepiece 10 conventionally includes a watch movement with a “timekeeping device” that drives an hour hand 30, a minute hand 31, and a small second hand 32. Col. 3, lines 8-12. *Schmiedchen* also discloses that “[t]he timekeeping device is **conventionally supplied with energy by a main barrel**” and that “large aperture date device 33 **completes the readings provided by the timekeeping device.**” Col. 3, lines 12-15 (emphases added). Therefore, according to *Schmiedchen*, aperture date device 33 is part of the timekeeping device, which is disclosed as having a single energy source (i.e., the main barrel). *Schmiedchen* does not disclose or suggest a “**display gearing**” of which one moving part carries a “**display disk**” (aperture date device 33 or otherwise) and a “**second energy source, connected mechanically to the display gearing,**” as recited in claim 1 (emphases added).

In support of the rejection of claim 1, the Examiner references col. 3, lines 8-67 of *Schmiedchen*. See Office Action, p. 2. However, that section of *Schmiedchen* simply confirms the deficiencies of *Schmeidchen*, as detailed above. Moreover, while there is a reference to an “auxiliary barrel BA” (see col. 3, lines 25-38), the auxiliary barrel BA of *Schmiedchen* supplies power only to the hammers of a striking work mechanism of a timer mechanism 100. The auxiliary barrel BA does not drive a “display disk” (aperture date device 33 or otherwise) nor does *Schmiedchen* disclose or teach any such arrangement. For this additional reason, *Schmiedchen* fails to disclose or suggest a **“display gearing of which one moving part carries the display disk”** and a **“second energy source, connected mechanically to the display gearing,”** as recited in claim 1 (emphases added).

Accordingly, for at least these reasons, *Schmiedchen* does not anticipate independent claim 1. Dependent claims 2, 3, and 7 are also allowable at least due to their dependence from claim 1. Claims 8-10, objected to as dependent upon claim 7, are also allowable for at least the reasons discussed above.

II. Rejection of Claims 4 and 6 under 35 U.S.C. §103(a)

Applicants respectfully traverse the Examiner’s rejection of claims 4 and 6 under 35 U.S.C. § 103(a), as being unpatentable over *Schmiedchen* in view of *Jolidon*. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P.

§ 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include] [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

A *prima facie* case of obviousness has not been established because Examiner has neither properly determined the scope and content of the prior art nor the differences between the prior art and the claims. Accordingly, the Examiner has not clearly articulated a reason why the prior art would render the rejected claims obvious to one of ordinary skill in the art.

Claims 4 and 6 depend from independent claim 1 and, thus, incorporate each and every element recited therein. As noted above, *Schmiedchen* fails to teach or suggest a display device intended to be fitted to a watch movement, where the display device includes, among other things, “a **display disk** for an additional function, a

display gearing of which one moving part carries the **display disk**, [and] a **second energy source, connected mechanically to the display gearing**,” as recited in amended claim 1 (emphases added).

Jolidon fails to cure the deficiencies of *Schmiedchen*. *Jolidon* relates to a device with time indicators driven by a first barrel connected to a first wheelwork and a first regulator organ, and an autonomous chronograph module with indicators driven by a second barrel independent from the first, connected to a second wheelwork and a second regulator organ. See Abstract, lines 1-6. Even if the teachings of *Schmiedchen* and *Jolidon* would have been obvious to combine, which Applicants do not concede, *Jolidon* does not overcome the deficiencies of *Schmiedchen*. That is, *Jolidon* also fails to teach or suggest, a display device intended to be fitted to a watch movement, where the display device includes, among other things, a “**display gearing** of which one moving part carries the **display disk**,” and a “**second energy source, connected mechanically to the display gearing**,” as recited in claim 1 from which claims 4 and 6 depend (emphasis added). Therefore, *Schmiedchen* and *Jolidon*, when taken alone or in any reasonable combination, fail to teach or suggest all the features of the claims.

In view of the mischaracterization of the references, as discussed above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claimed combination. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 4 and 6. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 4 and 6. Claim 5, objected to as dependent upon claim 4, is also allowable for at least the reasons discussed above.

CONCLUSION


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the rejections and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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